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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/604,946

06/27/2000

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06/17/2004

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EXAMINER

MCARDLE, JOSEPH M

ART UNIT

PAPER NUMBER

2132

DATE MAILED: 06/17/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/604,946

Applicant(s)

DEMELLO ET AL.

Examiner

Joseph McArdle

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/23/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 6, 9-13, 16-26, 28, 31-33 is/are rejected.
- 7) ☒ Claim(s) 3, 5, 7, 8, 14, 15, 27, 29, 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's arguments were persuasive in overcoming the grounds of rejection set forth in the previous office action. However, newly discovered prior art has necessitated new grounds of rejection. The new grounds of rejection appear below. The delay in citation of the new grounds of rejection is regretted.

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 4, 6, 16, 18, 21, 22, 23, 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Rose (U.S. Patent No. 5708709). In regards to claim 1, Rose discloses a design that pertains to managing the distribution of application programs in a network environment. Rose specifically discloses in column 3, lines 1-4 and in figure 1 that a client computer is connected to an information server via network interconnectivity means. It is also disclosed in the aforementioned locations that the client device contains a user interface along with storage devices. These disclosures meet the limitations set forth under claim 1 that call for having a computing device adapted to communicate via a network infrastructure comprising a long-term storage device as well as a user interface. Rose then discloses in column 8, lines 46-55 how an application builder can be installed on a client computer. The application builder is a program module (see column 8, lines 46-55) that provides for and performs various functions relating to the decryption and security of a requested application program. The application builder maintains the functionality of a rendering application called for

under claim 1 because of its ability to provide a user with a requested, decrypted, verified and functional application program. Rose further discloses in column 9, lines 12-20 that the application builder is capable of acting as the user's agent in requesting a particular application program from the trial license application program module (hereinafter referred to as the "TLAPM"). Rose also discloses in column 9, lines 41-46 that the TLAPM is capable of retrieving the appropriate version of the requested (by the user via the application builder) application program from storage. The aforementioned TLAPM maintains the functionality of a management module called for under claim 1 and is clearly separate from the application builder (rendering application). These disclosures by Rose meets the limitations set forth under claim 1 that call for having a management module (TLAPM), separate from the rendering application (application builder), that receives a communication (request) from the rendering application to access first information (application programs) from a storage. Rose further discloses in column 9, lines 57-59 that the application program is stored in an encrypted format. This disclosure meets the limitations set forth under claim 1 that calls for having the first information (application programs) stored in an encrypted format. Rose finally discloses in column 9, lines 48-53 that the TLAPM (management module) can also include header information in the application program to be sent that pertains to enabling the use of the application program. This disclosure meets the last limitation set forth under claim 1 that calls for having the management module return first data (see column 9, lines 48-53) which enables the use of the first information (application programs) by the rendering application.

2. In regards to claim 2, Rose further discloses in column 5, lines 31-38 and in figure 4 that copies of public keys are included with other information (first data) that allows for the decryption of requested application programs. This disclosure meets the limitations set forth under claim 2 that call for having the first data comprise a key to decrypt first information (application programs).

3. In regards to claim 4, Rose discloses in column 9, lines 39-52 how the TLAPM can provide additional information, such as expiration dates of requested application programs to the application builder. This disclosure meets the limitations set forth under claim 4 that call for having the management module (TLAPM) return transaction information (expiration dates) to the rendering application (program builder).

4. In regards to claim 6, Rose discloses in column 9, lines 6-20 that the TLAPM (management module) validates the application builder (rendering application) prior to usage. The disclosure meets the limitations set forth under claim 6 that call for having the management module authenticate the rendering application prior to returning first data.

5. In regards to claim 16, Rose discloses in column 9, lines 41-46 that the TLAPM (as described in the rejection of claim 1 above) is capable of interfacing with an application builder for the purposes of retrieving an appropriate version of an application program. This disclosure meets the limitations set forth under claim 16 that call for having a first entity that is capable of requesting at least one service via an interface being usable by first software (in the present case the application builder is representative of the first software). Rose then discloses in column 8, lines 46-55 how

an application builder is used to deliver and decrypt encrypted application programs to a client computer upon receiving a request for such data via the interface. This disclosure meets the limitations set forth under claim 16 that call for having a second entity that contains computer executable instructions to provide one or more services, which include enabling the use of information stored in an encrypted format (in the present case the application builder acts as the second entity and is capable of decrypting encrypted application programs to enable their use, wherein the computer executable instructions are invocable by way of the interface.

6. In regards to claim 18, the aforementioned application builder (see the above rejection of claim 16 and column 8, lines 46-55) acts as a digital content rendering application because of its ability to act as an access agent (column 9, lines 12-20) in order to request a particular application program. This disclosure meets the limitations set forth under claim 18 that call for having the first software comprise a digital content rendering application.

7. In regards to claim 21, Rose discloses in column 8, lines 46-55 (and as disclosed in the above rejection of claim 16) how an application builder is used to decrypt application programs. This disclosure meets the exact limitations set forth under claim 21.

8. In regards to claim 22, Rose further discloses in column 10, lines 21-25 that the application builder provides a private key in order to allow the usage (through decryption) of application programs. This disclosure meets the limitations set forth under claim 22 that call for providing a key to decrypt information.

9. In regards to claim 23, Rose discloses in column 10, lines 4-9 that the application builder uses client ID's in order to verify that a user is authorized. This disclosure meets the limitations set forth under claim 23 that call for providing the name of an authorized user of the information (through the use of client ID's).

10. In regards to claim 25, Rose discloses in column 10, lines 4-9 that the application builder is capable of authenticating itself with a users computer. This disclosure meets the limitations set forth under claim 25 that call for having one or more of the services include authenticating the first software.

11. In regards to claim 26, Rose discloses in column 9, lines 41-46 that the TLAPM is capable of interfacing with an application builder. This disclosure meets the limitation set forth under claim 26 that call for allowing the first entity (the TLAPM) to provide for itself because the TLAPM provides itself with its own means of interfacing with an application builder.

12. Claims 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang (U.S. Patent No. 5724425). In regards to claim 9, Chang discloses a design that that pertains to utilizing encryption techniques for enhancing software security and for distributing software. Chang further discloses in column 3, lines 58-65 how a users computer is capable of authenticating software to make certain that no unauthorized changes have been made to it. This disclosure meets the limitations set forth under claim 9 that call for authenticating software through the use of at least one cryptographic service. Chang also discloses in the aforementioned location that the users computer is responsible for authenticating the software in response to the software being distributed

to a users computer. This disclosure meets the limitations set forth under claim 9 that call for having instructions using a cryptographic service, which are separate from the software and invocable by the software.

13. In regards to claim 10, Chang discloses in column 3, lines 15-17 that public key encryption techniques are used for enhancing software security (i.e. authenticating). Chang also discloses in column 3, lines 53-54 that a key is used to decrypt data. These disclosures by Chang meet the limitations set forth under claim 10 that call for having a cryptographic key to decrypt data.

14. In regards to claims 11 and 12, Chang teaches in column 1, lines 35-50 that public key cryptography can be used to seal or tamper-proof data. Chang further teaches in the same location that this sealing or tamper-proofing of data is done by calculating an encrypted digest called a digital signature. Chang then goes on to disclose in column 1, lines 44-50 that the message digest (digital signature that seals the data) is sent, along with a key, to a receiver where it can be decrypted in order to unseal and verify the data (or software as in the present case). These disclosures meet the limitations of claim 11, which call for unsealing sealed data, as well as the limitations of claim 12, which call for allowing the sealed data to comprise a cryptographic key.

15. In regards to claim 13, Chang discloses in column 7, lines 52-67 how a software producer is capable of signing/sealing data with information pertaining to whom is licensed to use it. This disclosure meets the exact limitations set forth under claim 13.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rose in view of Chang. In regards to claim 28, Rose discloses a design in column 9, lines 12-20 that the application builder is capable of acting as the user's agent in requesting a particular application program from the TLAPM. Rose further discloses in column 9, lines 48-53 that the TLAPM can provide information that pertains to enabling the use of an encrypted application program. This disclosure meets the limitations set forth under claim 28 that call for issuing a first request for data which enables the use of information. However, Rose's design makes no mention of issuing a second request for second data, which includes second information, of the first information is sealed with the second information. Chang teaches in column 1, lines 36-40 that sealing data renders it tamper proof and that one such way of sealing data is to sign it with a digital signature. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Chang's teachings on sealing data with digital signatures into Rose's design in order to achieve a design that is capable of issuing a request for data that will unseal information if it is sealed for the purposes of providing additional security to the information (rendering it tamper proof).

18. In regards to claim 24, Rose's design disclosed above meets all of the aforementioned limitations set forth under claim 16. However, Rose's design makes no mention of having one or more of the services include unsealing at least some of the information. Chang teaches in column 1, lines 36-40 that sealing data renders it tamper-proof. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Chang's teachings on sealing data for rendering it tamper-proof in order to achieve a design that is capable of sealing and unsealing information for the purposes of ensuring that it can not be tampered with.

19. In regards to claim 31, Rose further discloses in column 5, lines 31-38 and in figure 4 that copies of public keys are included with other information (first data) that allows for the decryption of requested application programs. This disclosure meets the limitations set forth under claim 31 that call for having the first data comprise a key to decrypt first information (application programs).

20. Claims 20, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose in view of Benson (U.S. Patent No. 5845281). In regards to claims 20, 31, and 33, Rose's design disclosed above meets all of the aforementioned limitations set forth under claim 16. However, Rose's design makes no mention of allowing the computer instructions to comprise a COM object. Benson teaches in column 7, lines 33-40 that script or program code, which is executed by a user program, can contain conditional statements that are processed with the relevant object and system parameters on a user's processor. It would have been obvious to one of ordinary skill in

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the art at the time the invention was made to combine Benson's above teachings with Rose's design in order to achieve a design that is capable of issuing a request to an object that satisfies the request wherein the object is a COM object.

21. Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose in view of Schneck (U.S. Patent No. 5933498). In regards to claims 17 and 19, Rose's design disclosed above meets all of the aforementioned limitations set forth under claim 16. However, Rose's design makes no mention of allowing the first entity to be a developer of the first software and also to allow the second entity to be a consumer. Schneck discloses in column 9, lines 36-54 and in figure 1 a digital distribution system comprising a distribution entity and a consumer entity. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Schneck's teachings into Rose's design in order to achieve a design that is capable of allowing the first entity to comprise a developer and the second entity to comprise a user for the purpose of establishing a producer-consumer digital distribution system.

Allowable Subject Matter


22. Claims 3, 5, 7, 8, 14, 15, 27, 29 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

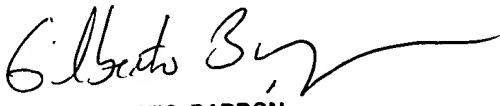
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph McArdle whose telephone number is (703) 305-7515. The examiner can normally be reached on Weekdays from 8:00 am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703) 305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Joseph McArdle
Examiner
Art Unit 2132

jmm


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